

Application No.: 10/008,468

Case No.: 55525US011

Remarks

Claims 32-37 are pending. Claims 1-31 have been withdrawn from consideration and are now canceled without prejudice to the filing of related applications. Claims 32 and 33 have been amended. Claims 38 and 39 have been added.

Please cancel claims 1-31.

New independent claim 38 recites the product limitations of the current invention and is no longer presented in product-by-process claim format. As previously noted by the Patent Office, in product-by-process claim format, only the product limitations are taken into consideration. (See, e.g., Paper No. 13, ¶¶ 4 and 5.) Thus, Applicants respectfully submit that the removal of the process steps results in claims that more accurately reflect the claims as examined by the Patent Office.

New claim 38 recites that the particles are non-magnetic. New claim 39 recites specific particles that may be embedded. Support for these amendments can be found at, e.g., page 4, line 28 – page 5, line 8.

Also, claim 38 requires the particles to be uniformly distributed and randomly spaced. Support for this amendment can be found at, e.g., page 11, lines 3-10.

Claims 32 and 33 was amended to depend from claim 38 rather than canceled claim 31.

§ 102 Rejections

Claims 31-33 stand rejected under 35 USC § 102(b) as purportedly being anticipated by Jin et al. (US 4,737,112).

Claim 31 has been canceled rendering the rejection of this claim moot.

The present invention provides a web comprising embedded particles, wherein the particles are non-magnetic. These particles are both uniformly distributed (i.e., number of particles per unit area) and randomly spaced from each other. (See claim 38. See, also, page 11, lines 3-6.)

In contrast, the method and products described by Jin require magnetic particles. (See, e.g., col. 2, lines 19-24; and col. 3, line 66 – col. 4, line 7.) In fact, Jin relies on the lateral

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repulsion between magnetic particles, which is generated by a uniform magnetic field, to prevent unintended contact between pairs of particles. (See, col. 2, line 64 – col. 3, line 5; and claim 1.) For at least this reason, Jin fails to describe, teach, or suggest all of the limitations of new claim 38; thus claim 38 is patentable over Jin. Claims 32 and 33 have been amended to depend from claim 38. Therefore, the rejection of claims 32-33 under 35 USC § 102(b) as being anticipated by Jin et al. has been overcome and should be withdrawn.

Claims 31-33 stand rejected under 35 USC § 102(b) as purportedly being anticipated by Calhoun et al. (US 5,240,761).

Claim 31 has been canceled rendering the rejection of this claim moot.

Claim 38 requires that substantially all of the particles be randomly spaced from each other, yet the particles are still uniformly distributed. Applicants respectfully submit that this is patentably distinct from products that have a uniform ordered pattern. (See, page 6, lines 15-16.)

In contrast, Calhoun describes a product in which most of the beads are uniformly spaced. That is, “a few are randomly spaced from their nearest neighbors,” but most of the beads have five or six nearest neighbors from which each is almost or substantially uniformly spaced. (Col. 6, lines 49-54, emphasis added.)

For at least this reason, Calhoun fails to describe, teach, or suggest all of the limitations of new claim 38; thus claim 38 is patentable over Calhoun. Claims 32-33 have been amended to depend from claim 38. Therefore, the rejection of claims 32-33 under 35 USC § 102(b) as being anticipated by Calhoun et al. has been overcome and should be withdrawn.

§ 103 Rejections

Claims 34-37 stand rejected under 35 USC § 103(a) as being unpatentable over Jin et al. (US 4,737,112) as applied to claims 31-33, and the Patent Office’s assertion that “[i]t would have been obvious for one having ordinary skill in the art to incorporate fibers including metal- or silver-coated fillers as the conductive particles because Jin et al. teach that such irregularly-shaped and metal-coated particles can equally function as spherical particles in terms of

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providing conductivity in the composite taught by Jin et al." (Office Action mailed February 19, 2004; ¶ 4.)

Claims 34-37 depend from claim 38. Claim 38 is patentable over Jin for at least the reasons stated above. Assuming, *arguendo*, that the Patent Office's assertions are correct, they fail to overcome the deficiencies of Jin. Thus the rejection of claims 34-37 under 35 USC § 103(a) as purportedly being unpatentable over Jin et al. has been overcome and should be withdrawn.

Claims 34-37 stand rejected under 35 USC § 103(a) as being unpatentable over Calhoun et al. (US 5,240,761) as applied to claims 31-33 above, and further in view of Glackin (US 5,082,595).

According to the Patent Office, Glackin discloses conductive fibrous filler such as metallic-coated fibers that provides electrical conductivity to an adhesive tape. The Patent Office further asserts that it would have been obvious for one having ordinary skill in the art to utilize fibers or particularly metal-coated fibers as conductive fillers in the adhesive tape of Calhoun; the motivation being to enhance the electrical conductivity as taught by Glackin.

Claims 34-37 depend from claim 38. For at least the reasons stated above, claim 38 is patentable over Calhoun. Assuming, *arguendo*, that the assertions regarding Glackin are correct, they fail to overcome the deficiencies of Calhoun. Thus, the rejection of claims 34-37 under 35 USC § 103(a) as being unpatentable over Calhoun et al. (US 5,240,761) in view of Glackin has been overcome and should be withdrawn.

New claim 39 depends from claim 38. Claim 38 is patentable for at least the reasons stated above; thus claim 39 is likewise patentable.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Allowance of claims 32-39, as amended, at an early date is solicited.

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Respectfully submitted,

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